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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
BOTTS, MICHAEL K	
ART UNIT	**PAPER NUMBER**
2176	

DATE MAILED: 04/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/579,256	KHATWANI ET AL.	
	Examiner	Art Unit	
	Michael K. Botts	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 February 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7,9-17,19-25,27-37 and 39-70* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,9-17,19-25,27-37 and 39-70* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This document is a Final Office Action on the merits. This action is responsive to the following communications: Response to Office Action, which was filed on February 13, 2006.

2. Applicants' attention is directed to the fact that a new examiner has been assigned to this case. The Examiner's name and telephone number are provided below.

3. Claims 1-7, 9-17, 19-25, 27-37, and 39-70 are currently pending in the case, with claims 1, 13, 32, 47, 48, 53, 60, 64, 65, 66, 67, 68, 69, and 70 being the independent claims.

4. Claims 1-7, 9-17, 19-25, 27-37, and 39-70 remain rejected.

Claims Rejection – 35 U.S.C. 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. **Claims 13-16, 19-24, 27-31, 53-55, 57, 58, and 66** are rejected under 35 U.S.C. 102(e) as being unpatentable over Imielinski et al., (U.S. Patent Application Publication 2002/0013792 A1, with priority to U.S. Provisional Application 60/173,757, which was filed on December 30, 1999) [hereinafter "Imielinski"].

Applicant's arguments, Response to Office Action, filed February 13, 2006, with respect to the rejections of claims 13-16, 19-24, 27-31, 53-55, 57, 58, and 66 under 35 U.S.C. 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of 35 U.S.C. 103(a).

Regarding **independent claims 13, 53, and 66**:

Imielinski discloses receiving a first web document in fig. I and paragraphs (0036) – (0040). The first web document is called the original electronic document in Imielinski. Imielinski teaches receiving a request to change a font attribute of a selected portion of the first web document in fig. 4, fig. 9B, paragraphs (0049) - (0054), and (0067). Imielinski also provides an example in paragraph (0014) that virtual tags, for example, could be used to display text of the original document in a red font on the virtual page. Imielinski discloses creating in the web browser a second web document from the first web document wherein the font attribute, within the second web document, of the selected portion is changed in response to receiving the request to change the font attribute of the selected portion, wherein the first web document and the second web document are markup language documents in fig. 1, fig. 3, paragraphs (0036) – (0040), and paragraphs (0042) - (0048). In Imielinski, the second web document is called the virtual page. The virtual page is the requested portion of the original electronic document that selected and customized according to the transformation rules generated by the user. See also Response to Arguments, made applicable herein by this reference.

Regarding **dependent claims 14 and 54**:

Imielinski discloses wherein the step of creating the second web document includes inserting virtual font indicators before and after text within the selected portion in fig. 4, fig. 9B, paragraphs (0049) - (0054), and (0067). Imielinski also provides an example in paragraph (0014) that virtual tags, for example, could be used to display the selected text of the original document in a red font on the virtual page.

Regarding **dependent claim 15**:

Imielinski discloses sending the second web document to an output device in fig. and paragraphs (0042) - (0048).

Regarding **dependent claims 16 and 55**:

Imielinski discloses wherein the output device is a display device in fig. 3 and paragraphs (0042) - (0048). Imielinski discloses wherein the selected portion is displayed according to the virtual font indicators in fig. 4, fig. 9B, paragraphs (0049) - (0054), and (0067).

Regarding **dependent claim 19**:

Imielinski discloses wherein the virtual font indicators include tags in fig. 1-3 and paragraph (0036) - (0048).

Regarding **dependent claim 20**:

Imielinski discloses wherein the markup language is hypertext markup language in paragraphs (0011) and (0015).

Regarding **dependent claim 21**, Imielinski discloses wherein the virtual font indicators include hypertext markup language tags in fig. 1-3 and paragraph (0036) - (0048).

Regarding **dependent claims 22 and 57**:

Imielinski discloses identifying at least one font indicator associated with text within the selected portion of the first web document, wherein the step of creating the second web document includes modifying the font attribute of the associated at least one font indicator in fig. 9B and paragraph (0067).

Regarding **dependent claim 23**:

Imielinski discloses sending the second web document to an output device in fig. 3 and paragraphs (0042) - (0048).

Regarding **dependent claims 24 and 58**:

Imielinski discloses wherein the output device is a display device in fig. and paragraphs (0042) - (0048). Imielinski discloses wherein the selected portion is displayed according to the virtual font indicators in fig. 4, fig. 9B, paragraphs (0049) - (0054), and (0067).

Regarding **dependent claim 27**:

Imielinski discloses wherein the at least one font indicator includes a tag in fig. 1-3 and paragraph (0036) – (0048).

Regarding **dependent claim 28**:

Imielinski discloses wherein the markup language is hypertext markup language in paragraphs (0011) and (0015).

Regarding **dependent claim 29**:

Imielinski discloses wherein the at least one font indicator includes a hypertext markup language tag in paragraphs (0011) and (0015).

Regarding **dependent claim 30**:

Imielinski discloses creating a copy of the first web document and changing the font attribute of the selected portion within the copy of the first web document in fig. 9B and paragraph (0067).

Regarding **dependent claim 31**:

Imielinski discloses changing the font attribute of the selected portion within the first web document to create the second web document in fig. 98 and paragraph (0067).

6. **Claims 1-7, 9-12, 17, 25, 32-37, 39-48, 51, 52, 56, 59-65, and 67-70** remain rejected under 35 U.S.C. 103(a) as being unpatentable over Imielinski et al., (U.S. Patent Application Publication 2002/0013792 A1, with priority to U.S. Provisional Application 60/173,757, which was filed on December 30, 1999) [hereinafter "Imielinski"], and further in view of Batres (U.S. Patent 6,832,351 B1, filed October 1, 1999) [hereinafter "Batres"].

Regarding **independent claims 1, 48, and 65**:

Imielinski teaches receiving a first web document including formatting information used to display the first web document in fig. 1 and paragraphs (0036) - (0040). The first web document is called the original electronic document in Imielinski. Imielinski teaches receiving a request to present a selected portion of the first web document in fig. 1, fig. 3, paragraphs (0036) - (0040), and paragraphs (0042) - (0048). The request and selected portion are defined in the transformation information of Imielinski. Imielinski teaches identifying formatting information associated with the selected portion of the first web document and creating in the web browser a second web document including the selected portion and the formatting information associated with the selected portion, in response to receiving the request, wherein the first web document and the second web document are markup language documents in fig. 1, fig. 3, paragraphs (0036) – (0040), and paragraphs (0042) - (0048). In Imielinski the second web document is called the virtual page. The virtual page is the requested portion of the original electronic document that selected and customized according 'to the

transformation rules generated by the user. Imielinski teaches responsive to a request to change a font attribute of the selected portion, inserting virtual font indicators before and after text within the selected portion in fig. 4, fig. 9B, paragraphs (0049) - (0054), and (0067). Imielinski also provides an example in paragraph (0014) that virtual tags, for example, could be used to display text of the original document in a red font on the virtual page. Imielinski does not teach responsive to a request to identify a page break in the selected portion, inserting at least one virtual page break indicator within the selected portion.

Batres does teach enhancing a web document by inserting and manipulating one or more virtual page break indicators to implement pagination for printing preview in fig. 2, fig. 5, col. 2 lines 28-43, col. 4 line 57 - col. 5 line 52, col. 8 lines 20-46. Batres teaches that the HTML preview rendering can accept data manipulation, formatting, and content changes. Batres also teaches that the page breaks are part of the multiple-page HTML format documents as described in col. 8 lines 20-46.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Imielinski and Batres to have created the claimed invention. It would have been obvious and desirable to have used the HTML preview rendering as taught by Batres to have improved the virtual page creation and display as taught by Imielinski. The combination would have enabled a user to have further manipulated a virtual page, including page breaks, to have previewed and prepared the document for output to a printing device.

Regarding **dependent claim 2**:

Imielinski teaches sending the second web document to an output device in fig. 3 and paragraphs (0042) – (0048).

Regarding **dependent claim 3**:

Imielinski does not teach wherein the output device is a printer.

Batres does wherein the output device is a printer in the abstract, col. 1 line 62 - col. 2 line 9, and col. 4 line 57 - col. 5 line 52.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Imielinski and Batres to have created the claimed invention. It would have been obvious and desirable to have used the HTML preview rendering as taught by Batres to have improved the virtual page creation and display as taught by Imielinski. The combination would have enabled a user to have further manipulated a virtual page, including page breaks, to have previewed and prepared the document for output to a printing device.

Regarding **dependent claim 4**:

Imielinski teaches wherein the output device is a display device in fig. 3 and paragraphs (0042) - (0048).

Regarding **dependent claims 5 and 51**:

Imielinski teaches receiving a request to change a font attribute of a selected portion of a web document and creating in the web browser a virtual page from the web document, wherein the font attribute, within the virtual page, of the selected portion is changed in response to receiving the request to change the font attribute of the selected portion in fig. 4, fig. B, paragraphs (0049) - (0054), and (0067). Imielinski teaches in paragraph (0040) that the transformation rules may be applied to the original electronic document, a second electronic document having a similar structure as the original electronic document, or all future instances of the original electronic document. Therefore, Imielinski teaches that a future instance of the original electronic document is the second web document and the virtual page is then the third web document.

Regarding **dependent claims 6 and 52**:

Imielinski does not teach receiving a request to display page break indicators within a web document, identifying page break information for the web document for an output device, and creating in the web browser a fourth web document from the third web document wherein at least one virtual page break indicator is inserted into the fourth web document, in response to the page break information, to indicate the location of page breaks. Imielinski teaches in paragraph (0040) that the transformation rules may be applied to the original electronic document, a second electronic document having a similar structure as the original electronic document, or all future instances of the original electronic document. Therefore, Imielinski teaches that a future instance of

the original electronic document is the third web document and the virtual page is then the fourth web document.

Batres does teach enhancing a web document by inserting and manipulating one or more virtual page break indicators to implement pagination for printing preview in fig. 2, fig. 5, col. 2 lines 28-43, col. 4 line 57 - col. 5 line 52, col. 8 lines 20-46. Batres teaches that the HTML preview rendering can accept data manipulation, formatting, and content changes. Batres also teaches that the page breaks are part of the multiple-page HTML format documents as described in col. 8 lines 20-46.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Imielinski and Batres to have created the claimed invention. It would have been obvious and desirable to have used the HTML preview rendering as taught by Batres to have improved the virtual page creation and display as taught by Imielinski. The combination would have enabled a user to have further manipulated a virtual page, including page breaks, to have previewed and prepared the document for output to a printing device.

Regarding **dependent claim 7**:

Imielinski does not teach receiving a request to display page break indicators within a web document, identifying page break information for the web document for an output device, and creating in the web browser a fourth web document from the third web document wherein at least one virtual page break indicator is inserted into the fourth web document, in response to the page break information, to indicate the location

of page breaks. Imielinski teaches in paragraph (0040) that the transformation rules may be applied to the original electronic document, a second electronic document having a similar structure as the original electronic document, or all future instances of the original electronic document. Therefore, Imielinski teaches that a future instance of the original electronic document is the second web document and the virtual page is then the third web document.

Batres does teach enhancing a web document by inserting and manipulating one or more virtual page break indicators to implement pagination for printing preview in fig. 2, fig. 5, col. 2 lines 28-43, col. 4 line 57 - col. 5 line 52, col. 8 lines 20-46. Batres teaches that the HTML preview rendering can accept data manipulation, formatting, and content changes. Batres also teaches that the page breaks are part of the multiple page HTML format documents as described in col. 8 lines 20-46.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Imielinski and Batres to have created the claimed invention. It would have been obvious and desirable to have used the HTML preview rendering as taught by Batres to have improved the virtual page creation and display as taught by Imielinski. The combination would have enabled a user to have further manipulated a virtual page, including page breaks, to have previewed and prepared the document for output to a printing device.

Regarding **dependent claim 9**:

Imielinski teaches wherein the formatting information includes tags in fig. 1-3 and paragraph (0036) – (0048).

Regarding **dependent claim 10**:

Imielinski teaches wherein the markup language is hypertext markup language in paragraphs (0011) and (0015).

Regarding **dependent claim 11**:

Imielinski teaches wherein the formatting information includes hypertext markup language tags in paragraphs (0011) and (0015).

Regarding **dependent claim 12**:

Imielinski teaches wherein the formatting information includes a header in (0011) and (0015).

Regarding **dependent claims 17 and 56**:

Imielinski teaches wherein the selected portion is outputted according to the virtual font indicators in fig. 4, fig. 9B, paragraphs (00491 - (0054), and (0067). Imielinski does not teach wherein the output device is a printer.

Batres does wherein the output device is a printer in the abstract, col. 1 line 62 - col. 2 line 9, and col. 4 line 57 - col. 5 line 52.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Imielinski and Batres to have created the claimed invention. It would have been obvious and desirable to have used the HTML preview rendering as taught by Batres to have improved the virtual page creation and display as taught by Imielinski. The combination would have enabled a user to have further manipulated a virtual page, including page breaks, to have previewed and prepared the document for output to a printing device.

Regarding **dependent claims 25 and 59**:

Imielinski teaches wherein the selected portion is outputted according to the virtual font indicators in fig. 4, fig. 9B, paragraphs (0049) - (0054), and (0067). Imielinski does not teach wherein the output device is a printer.

Batres does wherein the output device is a printer in the abstract, col. 1 line 62 - col. 2 line 9, and col. 4 line 57 - col. 5 line 52.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Imielinski and Batres to have created the claimed invention. It would have been obvious and desirable to have used the HTML preview rendering as taught by Batres to have improved the virtual page creation and display as taught by Imielinski. The combination would have enabled a user to have further manipulated a virtual page, including page breaks, to have previewed and prepared the document for output to a printing device.

Regarding **independent claims 32, 60 and 67**:

Imielinski teaches receiving a first web document in fig. 1 and paragraphs (0036) - (0040). The first web document is called the original electronic document in Imielinski. Imielinski teaches creating in the web browser a second web document from the first web document, wherein the first web document and second web document are markup language documents in fig. 1, fig. 3, paragraphs (0036) - (0040), and paragraphs (0042) – (0048). In Imielinski the second web document is called the virtual page. The virtual page is the requested portion of the original electronic document that selected and customized according to the transformation rules generated by the user. Imielinski does not teach receiving a request to display page break indicators within the first web document, identifying page break information for the first web document for an output device, and inserting at least one virtual page break indicator into the second web document, in response to the page break information, to indicate the location of page breaks.

Batres does teach enhancing a web document by inserting and manipulating one or more virtual page break line 57 - col. 5 line 52, col. 8 lines 20-46. Batres teaches that the HTML preview rendering can accept data manipulation, formatting, and content changes. Batres also teaches that the page breaks are part of the multiple-page HTML format documents as described in col. 8 lines 20-46.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Imielinski and Batres to have created the claimed invention. It would have been obvious and desirable to have used

the HTML preview rendering as taught by Batres to have improved the virtual page creation and display as taught by Imielinski. The combination would have enabled a user to have further manipulated a virtual page, including page breaks, to have previewed and prepared the document for output to a printing device.

Regarding **dependent claims 33 and 61**:

Imielinski does not teach removing the at least one virtual page break indicator and printing the second web document.

Batres does teach Batres does teach enhancing a web document by inserting and manipulating one or more virtual page break indicators to implement pagination for printing preview in fig. 2, fig. 5, col. 2 lines 28-43, col. 4 line 57 - col. 5 line 52, col. 8 lines 20-46. Batres teaches that the HTML preview rendering can accept data manipulation, formatting, and content changes. Batres also teaches that the page breaks are part of the multiple-page HTML format documents as described in col. 8 lines 20-46.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Imielinski and Batres to have created the claimed invention. It would have been obvious and desirable to have used the HTML preview rendering as taught by Batres to have improved the virtual page creation and display as taught by Imielinski. The combination would have enabled a user to have further manipulated a virtual page, including page breaks, to have previewed and prepared the document for output to a printing device.

Regarding **dependent claims 34 and 62**:

Imielinski does not teach replacing the at least one virtual page break indicator with at least one forced page break and printing the second web document.

Batres does teach enhancing a web document by inserting and manipulating one or more virtual page break indicators to implement pagination for printing preview in fig. 2, fig. 5, col. 2 lines 28-43, col. 4 line 57 - col. 5 line 52, col. 8 lines 20-46. Batres teaches that the HTML preview rendering can accept data manipulation, formatting, and content changes. Batres also teaches that the page breaks are part of the multiple-page HTML format documents as described in col. 8 lines 20-46.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Imielinski and Batres to have created the claimed invention. It would have been obvious and desirable to have used the HTML preview rendering as taught by Batres to have improved the virtual page creation and display as taught by Imielinski. The combination would have enabled a user to have further manipulated a virtual page, including page breaks, to have previewed and prepared the document for output to a printing device.

Regarding **dependent claims 35 and 63**:

Imielinski teaches sending the second web document to an output device in fig. 3 and paragraphs (0042) - (0048).

Regarding **dependent claim 36**:

Imielinski does not teach wherein the output device is a printer.

Batres does wherein the output device is a printer in the abstract, col. 1 line 62 - col. 2 line 9, and col. 4 line 57 - col. 5 line 52. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Imielinski and Batres to have created the claimed invention.

It would have been obvious and desirable to have used the HTML preview rendering as taught by Batres to have improved the virtual page creation and display as taught by Imielinski. The combination would have enabled a user to have further manipulated a virtual page, including page breaks, to have previewed and prepared the document for output to a printing device.

Regarding **dependent claim 37**:

Imielinski teaches wherein the output device is a display device in fig. 3 and paragraphs (0042) - (0048).

Regarding **dependent claim 39**:

Imielinski teaches virtual tags for implementing formatting in the second web document in fig. 1-3 and paragraph (0036) - (0048). Imielinski does not teach a virtual page break indicator.

Batres does teach enhancing a web document by inserting and manipulating one or more virtual page break indicators to implement pagination for printing preview in fig. 2, fig. 5, col. 2 lines 28-43, col. 4 line 57 - col. 5 line 52, col. 8 lines 20- 46. Batres teaches that the HTML preview rendering can accept data manipulation, formatting, and content changes. Batres also teaches that the page breaks are part of the multiple-page HTML format documents as described in col. 8 lines 20-46.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Imielinski and Batres to have created the claimed invention. It would have been obvious and desirable to have used the HTML preview rendering as taught by Batres to have improved the virtual page creation and display as taught by Imielinski. The combination would have enabled a user to have further manipulated a virtual page, including page breaks, to have previewed and prepared the document for output to a printing device.

Regarding **dependent claim 40**:

Imielinski teaches wherein the markup language is hypertext markup language in paragraphs (0011) and (0015).

Regarding **dependent claim 41**:

Imielinski teaches virtual tags for implementing formatting in the second web document in fig. 1-3 and paragraph (0036) - (0048). Imielinski does not teach a virtual page break indicator.

Batres does teach enhancing a web document by inserting and manipulating one or more virtual page break indicators to implement pagination for printing preview in fig. 2, fig. 5, col. 2 lines 28-43, col. 4 line 57 - col. 5 line 52, col. 8 lines 20- 46. Batres teaches that the HTML preview rendering can accept data manipulation, formatting, and content changes. Batres also teaches that the page breaks are part of the multiple-page HTML format documents as described in col. 8 lines 20-46.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Imielinski and Batres to have created the claimed invention. It would have been obvious and desirable to have used the HTML preview rendering as taught by Batres to have improved the virtual page creation and display as taught by Imielinski. The combination would have enabled a user to have further manipulated a virtual page, including page breaks, to have previewed and prepared the document for output to a printing device.

Regarding **dependent claim 42**:

Imielinski teaches creating a copy of the first web document and inserting at least one virtual tag into the copy of the first web document in fig. 1-3 and paragraph (0036) - (0048). Imielinski does not teach that the virtual tag is a virtual page break indicator.

Batres does teach enhancing a web document by inserting and manipulating one or more virtual page break indicators to implement pagination for printing preview in fig. 2, fig. 5, col. 2 lines 28-43, col. 4 line 57 - col. 5 line 52, col. 8 lines 20-46. Batres teaches that the HTML preview rendering can accept data manipulation, formatting, and

content changes. Batres also teaches that the page breaks are part of the multiple-page HTML format documents as described in col. 8 lines 20-46.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Imielinski and Batres to have created the claimed invention. û would have been obvious and desirable to have used the HTML preview rendering as taught by Batres to have improved the virtual page creation and display as taught by Imielinski. The combination would have enabled a user to have further manipulated a virtual page, including page breaks, to have previewed and prepared the document for output to a printing device.

Regarding **dependent claim 43**:

Imielinski teaches inserting at least one virtual tag into the first web document to create a second web document in fig. 1-3 and paragraph (0036) - (0048). Imielinski does not teach that the virtual tag is a virtual page break indicator.

Batres does teach enhancing a web document by inserting and manipulating one or more virtual page break indicators to implement pagination for printing preview in fig. 2, fig. 5, col. 2 lines 28-43, col. 4 line 57 - col. 5 line 52, col. 8 lines 20-46. Batres teaches that the HTML preview rendering can accept data manipulation, formatting, and content changes. Batres also teaches that the page breaks are part of the multiple-page HTML format documents as described in col. 8 lines 20-46.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Imielinski and Batres to have

created the claimed invention. It would have been obvious and desirable to have used the HTML preview rendering as taught by Batres to have improved the virtual page creation and display as taught by Imielinski. The combination would have enabled a user to have further manipulated a virtual page, including page breaks, to have previewed and prepared the document for output to a printing device.

Regarding **dependent claim 44**:

Imielinski does not teach sending the first web document to a device driver and receiving page break information corresponding to the first web document form the device driver.

Batres does teach enhancing a web document by inserting and manipulating one or more virtual page break indicators via a device driver to implement pagination for printing preview in fig. 2, fig. 5, col. 2 lines 28-43, col. 4 line 57 - col. 5 line 52, col. 8 lines 20-46. Batres teaches that the HTML preview rendering can accept data manipulation, formatting, and content changes. Batres also teaches that the page breaks are part of the multiple-page HTML format documents as described in col. 8 lines 20-46.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Imielinski and Batres to have created the claimed invention. It would have been obvious and desirable to have used the HTML preview rendering as taught by Batres to have improved the virtual page creation and display as taught by Imielinski. The combination would have enabled a

user to have further manipulated a virtual page, including page breaks, to have previewed and prepared the document for output to a printing device.

Regarding **dependent claim 45**:

Imielinski does not teach wherein the device driver is a printer driver.

Batres does teach enhancing a web document by inserting and manipulating one or more virtual page break indicators via a printer driver to implement pagination for printing preview in fig. 2, fig. 5, col. 2 lines 28-43, col. 4 line 57 - col. 5 line 52, col. 8 lines 20-46. Batres teaches that the HTML preview rendering can accept data manipulation, formatting, and content changes. Batres also teaches that the page breaks are part pf the multiple-page HTML format documents as described in col. 8 lines 20-46.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Imielinski and Batres to have created the claimed invention. It would have been obvious and desirable to have used the HTML preview rendering as taught by Batres to have improved the virtual page creation and display as taught by Imielinski. The combination would have enabled a user to have further manipulated a virtual page, including page breaks, to have previewed and prepared the document for output to a printing device.

Regarding **dependent claim 46**:

Imielinski does not teach identifying the location of at least one page break based on page setup information, document formatting information, and document content.

Batres does teach identifying the location of at least one page break based on page setup information, document formatting information, and document content in fig. 2, fig. 5, col. 2 lines 28-43, col. 4 line 57 - col. 5 line 52, col. 8 lines 20-46. Batres teaches that the HTML preview rendering can accept data manipulation, formatting, and content changes. Batres also teaches that the page breaks are part of the multiple-page HTML format documents as described in col. 8 lines 20-46.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Imielinski and Batres to have created the claimed invention. It would have been obvious and desirable to have used the HTML preview rendering as taught by Batres to have improved the virtual page creation and display as taught by Imielinski. The combination would have enabled a user to have further manipulated a virtual page, including page breaks, to have previewed and prepared the document for output to a printing device.

Regarding **independent claims 47, 64, and 68**:

Imielinski teaches receiving a first web document in fig. 1 and paragraphs (0036) - (0040). The first web document is called the original electronic document in Imielinski. Imielinski teaches receiving a request to perform an action, wherein the request to perform an action comprises a request to present a selected portion of the first web

document in fig. 1, fig. 3, paragraphs (0036) - (0040), and paragraphs (0042) - (0048). The request and selected portion are defined in the transformation information of Imielinski. Imielinski teaches wherein the request to perform an action comprises a request to change a font attribute of a selected portion of the first web document in fig. 4, fig. 9B, paragraphs (0049) - (0054), and (0067). Imielinski also provides an example in paragraph (0014) that virtual tags, for example, could be used to display text of the original document in a red font on the virtual page. Imielinski teaches creating in the web browser a second web document comprising at least a portion of the first web document in response to receiving the request, wherein the first web document and the second web document are markup language documents in fig. 1, fig. 3, paragraphs (0036) - (0040), and paragraphs (0042) - (0048). In Imielinski the second web document is called the virtual page. The virtual page is the requested portion of the original electronic document that selected and customized according to the transformation rules generated by the user. Imielinski does not teach wherein the request to perform an action comprises a request to display page break indicators within the first web document.

Batres does teach enhancing a web document by inserting and manipulating one or more virtual page break indicators via a printer driver to implement pagination for printing preview in fig. 2, fig. 5, col. 2 lines 28-43, col. 4 line 57 - col. 5 line 52, col. 8 lines 20-46. Batres teaches that the HTML preview rendering can accept data manipulation, formatting, and content changes. Batres also teaches that the page

breaks are part of the multiple-page HTML format documents as described in col. 8 lines 20-46.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Imielinski and Batres to have created the claimed invention. It would have been obvious and desirable to have used the HTML preview rendering as taught by Batres to have improved the virtual page creation and display as taught by Imielinski. The combination would have enabled a user to have further manipulated a virtual page, including page breaks, to have previewed and prepared the document for output to a printing device.

Regarding **independent claim 70**:

Imielinski teaches an interface means for allowing a user to interface with a web browser application and a communication means for receiving a first web document from a network in fig. 1, fig. 3, paragraphs (0036) - (0040), and paragraphs (0042) - (0048). The first web document is called the original electronic document in Imielinski. Imielinski teaches a creation and editing means with a mode of operation in which the creation and editing means receives a request to present a selected portion of the first web document in fig. 1, fig. 3, paragraphs (0036) - (0040), and paragraphs (0042) – (0048). The request and selected portion are defined in the transformation information of Imielinski. Imielinski teaches identifying formatting information associated with the selected portion of the first web document and creating in the web browser a second web document including the selected portion and the formatting information associated

with the selected portion, in response to receiving the request, wherein the first web document and the second web document are markup language documents in fig. 1, fig. 3, paragraphs (0036) - (0040), and paragraphs (0042) - (0048). In Imielinski the second web document is called the virtual page. The virtual page is the requested portion of the original electronic document that selected and customized according to the transformation rules generated by the user. Imielinski teaches a creation and editing means with a mode of operation in which the creation and editing means receives a request from interface means to change a font attribute of the selected portion of the first web document in fig. 4, fig. 9B, paragraphs (0049) - (0054), and (0067). Imielinski also provides an example in paragraph (0014) that virtual tags, for example, could be used to display text of the original document in a red font on the virtual page. Imielinski creating in the web browser a second web document including the selected portion and the formatting information associated with the selected portion, in response to receiving the request, wherein the font attribute of the selected portion within the second web document is changed in response to receiving the request to change the font attribute of the selected portion in fig. 1, fig. 3, fig. 4, fig. 9B, paragraphs (0036) - (0040), (0042) - (0054), and (0067). In Imielinski, the second web document is called the virtual page. The virtual page is the requested portion of the original electronic document that selected and customized according to the transformation rules generated by the user. Imielinski does not teach a creation and editing means with a mode of operation in which the creation and editing means receives a request from the interface means to display page break indicators within the first web document, identifies page break

information corresponding to the first web document, and creates in the web browser a second web document from the first web document, wherein at least one virtual page break indicator is inserted into the second web document, in response to the page break information, to indicate the location of page breaks.

Batres does teach enhancing a web document by inserting and manipulating one or more virtual page break indicators to implement pagination for printing preview in fig. 2, fig. 5, col. 2 lines 28-43, col. 4 line 57 - col. 5 line 52, col. 8 lines 20-46. Batres teaches that the HTML preview rendering can accept data manipulation, formatting, and content changes. Batres also teaches that the page breaks are part of the multiple-page HTML format documents as described in col. 8 lines 20-46. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Imielinski and Batres to have created the claimed invention.

It would have been obvious and desirable to have used the HTML preview rendering as taught by Batres to have improved the virtual page creation and display as taught by Imielinski. The combination would have enabled a user to have further manipulated a virtual page, including page breaks, to have previewed and prepared the document for output to a printing device.

Response to Arguments

As an overall position, Applicants argue that certain prior art teachings in the Imielinski Patent Application Publication, "Imielinski," as cited above, are not supported by the underlying Imielinski Provisional Application 60/173,757, [hereinafter the

"Provisional Application"]. Applicants argue that the priority date of certain subject matter should be the filing of the Application, and not the Provisional Application, arguing that the Provisional Application fails to teach certain limitations of the claims. Applicants argue further that only the information disclosed in the Provisional Application may be used as prior art because any added material in Imielinski when filed in the Non-Provisional Application does not qualify as prior art. See, Response to Office Action, page 18.

The standard for evaluating whether a preceding Provisional Application properly supports the subject matter relied upon to make a rejection based on a Non-Provisional Application is whether the subject matter meets the requirements of 35 U.S.C. 112, first paragraph. See, MPEP, 2136.03(III).

The inquiry is not whether a claim limitation in question is taught expressly in the underlying Provisional Application under a 35 U.S.C. 102 analysis, but whether the subject matter cited as prior art is properly supported by the underlying Provisional Application under a 35 U.S.C. 112, first paragraph analysis. Upon a finding that the subject matter in the Non-Provisional Application is properly supported by the underlying Provisional Application, under the 35 U.S.C. 112, first paragraph analysis, then the subject matter is entitled to the benefit of the earlier filing date. Accordingly, the expression of the subject matter in the Non-Provisional Application is also accorded the benefit of the earlier filing date and citation to the underlying Provisional Application is not necessary.

Regarding the rejections of **claims 13-16, 19-24, 27-31, 53-55, 57, 58, and 66**:

Under the standard expressed above, the Examiner believes the rejection of claims 13-16, 19-24, 27-31, 53-55, 57, 58, and 66 under 35 U.S.C. 102(e) to have been proper. The Examiner also recognizes a colorable argument in Applicants' Response to Office action in that the strength of citation to the Non-Provisional Application of Imielinski turns on interpretation of whether the subject matter was supported by the prior Provisional Application. Upon consideration of Applicants' arguments, the Examiner withdraws the rejection of claims 13-16, 19-24, 27-31, 53-55, 57, 58, and 66 under 35 U.S.C. 102(e). However, upon further consideration, a new ground of rejection is made under 35 U.S.C. 103(a). Accordingly, Applicants' arguments regarding 35 U.S.C. 102(e) are moot.

Applicants argue that the Provisional Application does not teach the following limitations as recited in independent claim 13: "*receiving a request to change a font attribute of a selected portion of the first web document; and creating in the web browser a second web document from the first web document, wherein the font attribute, within the second web document, of the selected portion is changed in response to receiving the request to change the font attribute of the selected portion, wherein the first web document and the second web document are markup language document.*" See, Response to Office Action, pages 17 and 18.

Applicant fails to specifically identify which elements of the cited portion of claim 13 are not taught by the Provisional Application. It is believed by the Examiner that the deficiency in the cited prior art related to the limitation "receiving a request to change a

font attribute." See, Response to Office Action, page 18.

Since the Applicants quote solely from claim 13, only claim 13 will be addressed, and the response will apply to independent claims 53 and 56, and to dependent claims 14-16, 19-24, 27-31, 54, 55, 57, and 58 by virtue of their dependency on independent claims 13 and 53, according to the relationship argued by the Applicants. It is noted for clarification that the prior art cited against claim 13 was cited from the Patent Application Publication, "Imielinski."

Imielinski teaches creating a virtual page or second web document from a first web document using virtual tags. The virtual tags identify the original document content or a selected portion of the original document content for creation of the virtual page. The virtual tags have the ability to manipulate the formatting information, such as font attribute information, in the subsequent web document, called a virtual page by Imielinski. Batres teaches previewing and printing a web document via an HTML renderer. The content and formatting may be manipulating in the HTML renderer. Batres also defines a multiple-page HTML document, which can demarcate HTML document information among a plurality of pages. All limitations of claim 13 are taught in Imielinski, except that the limitation of a "font attribute" is not expressly taught in the Provisional Application. See, Provisional Application, page 5, line 30 through page 6, line 3.

The Provisional Application discusses modification of the text to color it red in order to draw attention to the text. See, Provisional Application, page 2, lines 27-29.

The Provisional Application is expressly not limited to the disclosed embodiments, and it is recognized that other arrangements can be readily devised by those skilled in the art.

Modification of the font attribute is expressly taught in Imielinski. See, Imielinski, fig. 9B, paragraph (0049) [Table 1], paragraph (0067) – (0068), and claims 6, 41, and 74.

It would have been obvious to one of ordinary skill in the art at the time of the invention to change the font in a text. The suggestion or motivation for doing so is taught in the Provisional Application that the tags can be "visualized on the source web page," with the obvious and beneficial advantage to changing text color or font being to draw the reader's attention to the text.

Regarding the rejections of **claims 14-16, 19-24, 27-31, 54, 55, 57, and 58**:

Applicants extend their arguments regarding independent claim 13 to independent claims 53 and 56, and further extend the argument to dependent claims 14-16, 19-24, 27-31, 54, 55, 57, and 58 by virtue of their dependency on independent claims 13 and 53. See, Response to Office Action, page 19.

Claims 14-16, 19-24, 27-31, 54, 55, 57, and 58 are rejected based on their dependency on rejected claims 13 and 53, above.

Conclusion

7. The following prior art is made of record and not relied upon that is considered pertinent to applicants' disclosure:

The following prior art is made of record:

Imielinski (Provisional Application 60/173,757, filed December 30, 1999), U.S. Patent and Trademark Office, Public PAIR.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael K. Botts whose telephone number is 571-272-5533. The examiner can normally be reached on Monday through Friday 8:00-4:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MKB/mkb

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